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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,201	07/29/2003	David Greenstein	N9601	5666

23456 7590 11/17/2004

WADDEY & PATTERSON
414 UNION STREET, SUITE 2020
BANK OF AMERICA PLAZA
NASHVILLE, TN 37219

EXAMINER

JONES, DAMERON L

ART UNIT PAPER NUMBER

1616

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/629,201	GREENSTEIN ET AL.	
	Examiner	Art Unit	
	D. L. Jones	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>11/9/04</u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the amendment filed 8/16/04 wherein the specification was amended and claims 9 and 14 were amended.

Note: Claims 9-14 are pending.

RESPONSE TO APPLICANT'S ARGUMENTS

2. The Applicant's arguments filed 8/16/04 to the rejection of claims 9-14 made by the Examiner under 35 USC 112 have been fully considered and deemed persuasive for reasons of record in Applicant's response. Therefore, all outstanding rejections are hereby withdrawn.

NEW GROUNDS OF REJECTION

112 Second Paragraph Rejections

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-19: Independent claims 1, 9, and 14 are ambiguous because of the phrase 'the test compound includes the anti-nematode agent' (see claims 1 and 14); the phrase 'composition includes the test compound and the polypeptide' (see claim 9); and the phrase 'the composition includes the test compound and the major sperm protein

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polypeptide' (claim 14). In particular, in each of the instances above, the term 'includes' should be replaced with 'is' for consistency throughout the specification and because in each instance, the composition is the test compound, test compound and the polypeptide, or the test compound and the major sperm protein polypeptide. It is noted that Applicant's claims are directed to a screening method that results in a test compound which may have more than one component. In other words, the way that Applicant has defined 'test compound', it is possible to have a test compound that is a composition. However, the use of 'includes' indicates that the test compound comprises an anti-nematode agent, for example, when the test compound is the anti-nematode agent. Thus, Applicant is respectfully requested to replace the phrase 'test compound includes the anti-nematode agent' with 'test compound is the anti-nematode agent' (see independent claims 1 and 14) and replace the phrase 'composition includes the test compound' with 'composition is the test compound and polypeptide' (see claims 9 and 14). Since, the independent claims are ambiguous, their respective dependent claims are vague and indefinite as well.

COMMENTS/NOTES


5. It should be noted that no prior art has been cited against Applicant's claims. However, Applicant MUST address and overcome the 112 rejections above. The claims are allowable over the prior art of record for reasons of record in the office action mailed 5/17/04.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
Art Unit 1616

November 12, 2004